REMARKS/ARGUMENTS

This paper is filed in response to the Office Action mailed November 19, 2004. In the Office Action the Examiner rejected pending claims 1-7, 9-21, 23, and 29. More specifically, the Examiner rejected claims 1-5, 7, 9-19, and 29 as being unpatentable over the combination of U.S. Patent No. 5,332,270 to Petty et al., (hereinafter "Petty"), U.S. Patent No. 5,112,560 to Moumdjian (hereinafter "Moumdjian"), and U.S. Patent No. 4,519,569 to Nolan (hereinafter "Nolan"). Claim 6 was rejected as being unpatentable under 35 U.S.C. §103(a) over the combination of Petty, Moumdjian, Nolan, and U.S. Patent No. 4,923,388 to Nakamura (hereinafter "Nakamura"). Claims 20-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Petty, Moumdjian, and Nolan.

Applicant has prepared the following arguments for the consideration of the Examiner relating to the claims as they currently stand. Applicant respectfully requests the reconsideration of the above-mentioned rejections in light of the following.

Claim Rejections – 35 U.S.C. §103

Claims 1-5, 7, 9-19, and 29 were rejected in the Office Action of November 19, 2004 as being unpatentable over Petty, Moumdjian, and Nolan. The Manual of Patent Examining Procedure explains the "three basic criteria" which "must be met" to establish a *prima facie* case of obviousness:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Only having met these three criteria is such an obviousness rejection proper. Further, "hindsight reconstruction [cannot be used] to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine,* 837 F.2d 1071, 1075 (Fed. Cir. 1988). The Federal Circuit's concept of

"hindsight" was further defined in *In re Dembiczak* when the Court stated that: "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak,* 175 F.3d 994, 999 (Fed. Cir. 1999). The Applicant asserts that this rejection is improper in light of the amendments submitted herewith, and respectfully requests its immediate withdrawal.

The rejection of pending claims 1-5, 7, 9-19, and 29 under 35 U.S.C. §103(a) is improper because the Examiner has failed to provide teachings of all of the elements of the asserted claims. In addition to this, the Examiner fails to provide suggestion or motivation to combine from the prior art and omits any suggestion of success in such a combination. Each of these deficiencies will be discussed in detail below.

First, the combination cited by the Examiner fails to provide teachings of each and every element of the claims as currently pending herein. The MPEP asserts that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03, *citing In re Wilson,* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In this case, the Examiner has failed to consider several words in pending independent claim 1 in order to reach his finding of obviousness.

First, claim 1 describes "a window mold member *projecting from a surface of the inner core die.*" Claim 1, (emphasis added). Independent claims 13 and 29 include similar limitations. *See* Claims 13, 29. In contrast, the window mold member of Petty taught in Figures 3A-3C, 6A-6C, 7A-7C, 8A-8C, 9A-9C, and in the Specification at *e.g.,* column 5, lines 14-48; column 6, lines 3-19 is a structure that projects inwardly from an external mold surface. Thus Petty fails to provide a window mold member "projecting from a surface of the inner core die" and this limitation is not met. Claim 1.

Nolan is next cited by the Examiner and described as teaching "an inner core (12) containing projections (Fig. 7) for forming a cap where the projections form the line of weakness (52) that is adapted to snap over a shoulder on the bottle neck . . . . The projections are ramped in shape." Office Action, pages 3 and 5. Although Nolan provides little textual disclosure (or labeled structural disclosure in the Figures) regarding these "projections" and the nature of the

"line of weakness" they form, the disclosure shows that the projections do not constitute a "window mold member" as required by claim 1. Specifically, the projections are shown in the figures and described in the specification as forming "a line of weakness 52 enabling the lower tamper-indicating portion of the cap to be torn off." Nolan, column 2, lines 59-61. Thus, the projections form a somewhat-thinned region, not a window as required by the claims of the present application.

Finally, Moumdjian provides no teaching of a window mold member. Since none of these references provides "a window mold member projecting from a surface of the inner core die," combining them is insufficient to support an obviousness rejection under 35 U.S.C. §103. As a result, the combination of these three members fails to teach this limitation of claim 1, rendering this rejection improper. Applicant respectfully requests its withdrawal with respect to claims 1-7, 9-19, and 29.

The 35 U.S.C. §103 rejection of claims 1-5, 7, 9-19 and 29 is also improper for failure to teach the limitation of "a boss disposed between the ramps to facilitate separation of the interior wall from the surface." Claim 1. As noted above, a combination of references must teach "all the claim limitations" in order to support a *prima facie* case of obviousness. *In re Vaeck,* 947 F.2d 488.

The Examiner cited Moumdjian for the teaching of "bosses (14) located on a die member (10)." Office Action, p. 3. The Examiner dismissed the limitation of the placement of the boss present in the above claims without support, stating "it would have been obvious to one of ordinary skill to place a boss between the ramps of the window mold to form the opening." *Id.* First, as discussed above, neither Petty, Nolan, nor Moumdjian teaches a "window mold member projecting from a surface of the inner core die." Claim 1.

Being a component of the window mold member, the boss taught in the present application is located on the inner core die. The Examiner argues that Petty teaches an opening (14) formed in the product by a boss, and thus, that "[i]t would have been obvious to one of ordinary skill in the art to have a boss on the mold core to form an opening in the product." Office Action, p. 3. The opening (14) referred to by the Examiner is illustrated in Figures 1, 2, 2A, 4, and 4A of Petty. In each of these Figures, the opening is shown to be merely an

indentation, not passing completely through the finger (9), and to have been produced from an outer mold structure, not from an inner core die. As a result, neither the placement of the boss on the inner core die nor its position is obvious based on the disclosure of Petty.

Applicant further wishes to note that the "projections" of Nolan may not be considered to be "bosses" as used in the claims of the present invention. Specifically, the projections taught in Nolan are taught to form the "line of weakness (52)" and to be unassociated with any other structure. Thus, Nolan provides no teaching of associating such projections with any other structures—indeed, association of Nolan's projections with other structures may interfere with the production of a "line of weakness" by providing regions that are structurally more secure or stable.

Finally, although Moumdjian provides teaching of the use of bosses, it provides no teaching of a boss placed on an inner core die as present in the pending claims. Thus, it provides no teaching of the claim limitation and also appears non-analogous to the present disclosure and the Petty and Nolan references it is sought to be combined with. The present invention and Petty and Nolan all relate to the injection molding of tubular structures and difficulties stemming from the use of a generally cylindrical inner core die which must be removed from the completed project. Moumdjian teaches a flat, layered die having three die members: outer, intermediate, and upper. *See, e.g.,* Figures 3-6 and Specification column 5, lines 46-55. The intermediate die member may be removed when the outer and upper layers are opened. Moumdjian, column 6, lines 11-18. This differs from the disclosure of the present invention, Petty and Nolan since such an intermediate layer could be peeled away from upper and lower layers while an inner core die must be drawn outwardly—a sliding motion which presents different design and engineering problems. Thus, since Petty, Nolan, and Moumdjian each fail to teach an inner core die having a boss, this rejection should also be withdrawn.

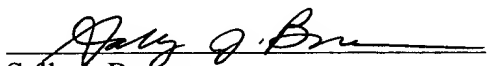
With regard to the rejection of claims 20, 21, and 23 directed to an inner core die (claim 22 having been previously cancelled), as discussed in detail above, Petty, Nolan, and Moumdjian each fail to teach the placement of either a window mold member or a boss on an inner core die. As a result, this rejection is also unsupported and should be withdrawn. More specifically, the window mold member of Petty taught in Figures 3A-3C, 6A-6C, 7A-7C, 8A-8C, 9A-9C, and in

the Specification at *e.g.*, column 5, lines 14-48; column 6, lines 3-19 projects inwardly from an external mold surface, not from an inner core die. Petty thus fails to provide a window mold member that meets the limitations of claim 20 of a "window mold member disposed on a side" of the inner core die, and this limitation is not met. Claim 20.

Nolan is cited as teaching "an inner core (12) containing projections (Fig. 7) for forming a cap where the projections form the line of weakness (52) that is adapted to snap over a shoulder on the bottle neck . . . . The projections are ramped in shape." Office Action, pages 3 and 5. The projections are shown in the figures and described in the specification as forming "a line of weakness 52 enabling the lower tamper-indicating portion of the cap to be torn off." Nolan, column 2, lines 59-61. Thus, the projections form a somewhat-thinned region, not a window as required by the claims of the present application, and thus fail to teach the "window mold member" limitation of claim 20. Moumdjian provides no teaching of a window mold member at all. Since each of the three cited references fails to teach "a window mold member," placed on an inner core die, combining them is insufficient to support an obviousness rejection under 35 U.S.C. §103. Applicant respectfully requests its withdrawal with respect to claims 20, 21, and 23.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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